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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,109	11/26/2001	Kenji Narumi	10873.711 USWO	9635
23552	7590	05/08/2006	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			TRAN, THANG V	
			ART UNIT	PAPER NUMBER
			2627	
DATE MAILED: 05/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/980,109	Applicant(s) NARUMI ET AL.	
	Examiner Thang V. Tran	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-19 is/are allowed.
- 6) ☒ Claim(s) 1-13 and 20-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

The communications dated 01/04/05 & 03/29/05 have been considered with the following results:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 and 20-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1:

The statement “wherein ... to be recorded”, lines 5-14, is directed to a desired result of a mark recorded on an optical information recording medium by the method of claim 1. However, it is unclear from the claim as to how the particular recorded mark as defined in the above statement is recorded on the recording medium by the irradiating step which is the only step recited in claim 1. Accordingly, no patentable weight is given to the statement above because it is directed to the desired result of the mark recorded on an optical information recording medium without any particular step provided in the claim to perform the recording in order to obtain such desired result.

In claims 2 and 3;

Limitations in claims 2 and 3 are also directed to the desired result of the mark recorded on the recording medium without any particular step provided in the claim to perform the recording in order to obtain such desired result.

In claim 4:

See the rejection applied to claim 1 above for the statement “wherein ... next unit recording area”, lines 5-17.

In claims 5-10 and 20-23:

Limitations in claims 5-10 and 19-23 are also directed to the desired result of the mark recorded on the recording medium without any particular step provided in the claim to perform the recording in order to obtain such desired result.

In claims 11 and 24:

It is unclear how a selecting step recited in claim (12 or 24) is relatively operated with the irradiating step as recited in parent claim (1 or 4). Also, it is unclear what is meant by “selecting whether ... type of information”. Did applicant intend to state that --detecting whether ... type of information--?

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-10, 13 and 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohno et al. (US 6,567,367)

Regarding claim 1, see Figs. 2a and 2b of Ohno et al which show an optical recording medium having a mark(3) recorded thereon by irradiating the optical recording medium with a

Art Unit: 2627

laser beam (4) to cause the change in optical characteristics of a photosensitive recording film so that information recorded as the mark (3) which has a mark area having a constant width and a space area having zero width defined as a unit recording area (see Fig. 2a), and the information is present by at least three different widths (see Fig. 2a) and the unit recording area having a predetermined length and predetermined width (see Fig. 2a) and the predetermined width is formed by correcting leading and trailing edge positions of a recording pulse in accordance with a width of the unit recording area to be recorded (see Figs. 7a-7c and column 14 line 56 to column 16, line 3).

Regarding claims 2, 3 and 7-10, see Figs. 7a-7c and column 14 line 56 to column 16, line 3, for limitations recited in these claims.

Regarding claim 4, see the rejection applied to claim 1 above.

Regarding claims 5, 6 and 20-23, see Figs. 7a-7c and column 14, line 56 to column 16, line 3, for limitations recited in these claims.

Regarding claim 13, see Fig. 1, 2, 7, 10 and column 14, line 56 to column 16, line 3 for limitation recited in these claims.

Allowable Subject Matter

5. Claims 11 and 24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 11 and 24 are allowable over the prior art of record because all references of record, considered as closest prior art and viewed in combination or individually, fails to suggest

Art Unit: 2627

or fairly teach an optical information recording method including a combination of all limitations as particularly recited in each of claims 11 and 24.

6. Claims 12 and 14-19 are allowed over the prior art of record.

Claim 12 is allowable over the prior art of record because all references of record, considered as closest prior art and viewed in combination or individually, fails to suggest or fairly teach an optical information recording medium including a combination of all limitations as particularly recited in this claim 12.

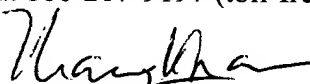
Claims 14-19 are allowed over the prior art of record because all references of record, considered as closest prior art and viewed in combination or individually, fails to suggest or fairly teach an optical information recording apparatus including a combination of all features and their relative functional operations as particularly recited in each of claims 14 and 17. Claims 15, 16, 18 and 19 are allowed with their respective parent claim.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thang V. Tran whose telephone number is (571) 272-7595. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nguyen Hoa can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thang V. Tran
Primary Examiner
Art Unit 2627